

REMARKS

I. Amendments to the Drawings

This amendment changes reference numerals in Figures 13, 15A, and 15B. These changes correspond to amendments made in the specification described below.

II. Amendments to the Specification

By this amendment, Applicants have corrected a typographical error on page 23 and have corrected various reference numerals for objects depicted in the figures on pages 35-38.

III. Amendments to the Claims

By this amendment, Applicants have withdrawn claims 1-20, 113-142, and 173-262, as being drawn to non-elected inventions; canceled claims 22, 33, 46, 57, 144, and 158; and amended claims 21, 29, 32, 40, 43-45, 53, 56, 64, 67-69, 90, 111, 112, 143, 157, 171, and 172. Applicants note that the limitations of now canceled claims 22, 33, 46, 57, 144, and 158 appear in independent claims 21, 32, 45, 56, 143, and 157, respectively.

Claims 21, 23-32, 34-45, 47-56, 58-112, 143, 145-157, and 159-172 are currently pending. Of these, claims 21, 32, 43-45, 56, 67-69, 90, 111, 112, 143, 157, 171, and 172 are independent.

A. Claim Objections

The Examiner objected to claim 40 for informalities. By this amendment, Applicants have amended claim 40, as suggested by the Examiner, to overcome this objection.

Applicants have also amended claims 29, 40, 53, 64, and 92 in order to correct typographical or grammatical errors. These amendments do not change the scope of the claims.

B. Claim Rejections - 35 U.S.C. § 112

Claims 69, 90, 111, 112, 143, 157, 171, and 172 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. By this amendment, Applicants have changed the recitation “the data file” to read “a data file” in each of the claims. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 112.

C. Claim Rejections - 35 U.S.C. § 102(b)

Claims 21-76, 80, 81, 83-86, 88-97, 101, 102, 104-107, 109-112, 143-153, 155-167, and 169-172 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,832,204 to Handy et al (“Handy”)¹. Of these claims, Applicants have, by this amendment, canceled claims 22, 33, 46, 57, 144, and 158.

¹ The Office Action sets forth many characterizations of the cited references. Applicants discuss selected ones of these characterizations in this Response. However, the lack of discussion does not indicate that Applicants agree with the characterizations set forth in the Office Action.

1. Claims 21-68

Currently amended claim 21 recites, among other things: “resolving mailpiece information for a bar code sorter using the identification file.” Handy fails to teach or suggest at least this element of claim 21.

The Office Action describes Handy as disclosing, in Figure 7, an identification file, which is SWAK information (70), and a bar code sorter labeled “sortation management system.” See Office Action, page 4. Handy appears to disclose the step of transmitting the identification file (SWAK information) to the bar code sorter (sortation management system). See Handy at column 6, lines 64-68. Elsewhere, Handy appears to disclose comparing the identification file (SWAK information) to a pick-up record (74). See Handy at column 7, lines 1-5. It appears this comparison is performed simply for verifying receipt of packages at a hub. However, neither Figure 7, highlighted by the Examiner, nor the above recited disclosures of Handy constitute “resolving mailpiece information for a bar code sorter using the identification file,” as recited in claim 21. Since Handy fails to teach each and every element of claim 21, claim 21 is not anticipated by Handy.

Independent claims 32, 43, 44, 45, 56, 67, and 68, although of different scope, each contain elements corresponding to the element of claim 21 discussed above. Therefore, claims 32, 43, 44, 45, 56, 67, and 68 are not anticipated by Handy for at least reasons similar to those discussed above with respect to claim 21.

For at least this reason, claims 21, 32, 43, 44, 45, 56, 67, and 68 are not anticipated by Handy. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 102(b).

Claims 23-31, 34-42, 47-55, and 58-66 depend from and add additional features to independent claims 21, 32, 43, 44, 45, 56, 67, and 68. Accordingly, these claims are allowable for at least the reasons set forth above.

2. Claims 69-112 and 143-172

Claim 69 recites, among other things: “generating a data file, using the service area table corresponding to the secondary identification code server to identify identification files in the lookup table; and transmitting the data file to the secondary identification code server.” Handy fails to teach or suggest at least this element of claim 69.

In support of this rejection, the Office Action refers to Figure 7 of Handy, and describes Handy as disclosing: “generating a data file using the service area table (the existence and use of the service area tables throughout the system mandates that they will be ‘used’ in all updates, as they are to be correlated among all modules for all item identifiers associated with files) corresponding to the secondary identification code server to identify identification files in the lookup table.” See Office Action, pages 11-12. In an earlier passage, the Office Action identifies the Central Computer (90) in Figure 7 of Handy as the secondary identification code server. See Office Action, page 4.

Claim 69 is not anticipated by Handy for at least the reason that Handy fails to disclose “generating a data file, using the service area table corresponding to the

secondary identification code server to identify identification files in the lookup table; and transmitting the data file to the secondary identification code server.” In Figure 7 of Handy, the only data files that appear to be transmitted to the secondary identification code server, or Central Computer (90), are represented by data lines 89 and 86². The data files transmitted along these data lines appear to be used for “package intercepts,” “tracing,” “service reports,” and ensuring “ultimate delivery to the consignee.” See Handy, column 7, lines 29-37. However, neither Figure 7 nor the above cited recitations of Handy constitute “generating a data file, using the service area table corresponding to the secondary identification code server to identify identification files in the lookup table; and transmitting the data file to the secondary identification code server,” as recited in claim 69.

In an earlier passage, the Office Action describes Handy as disclosing a lookup table, which is ordered and maintained in the Hub Master Computer (72) of Figure 7. See Office Action, page 5. In that passage, the Office Action also describes Handy as disclosing a service area table, which is ordered and maintained in the Central Computer (90) and Sortation Update File (86). See Office Action, page 5. Even assuming that such characterizations of Handy are correct, the above cited recitations of Handy do not constitute: “generating a data file, using the service area table corresponding to the secondary identification code server to identify identification files in

² Data line 86 shown in Figure 7 of Handy appears to be incorrectly labeled because elsewhere Handy refers to this data line as information 87. See, e.g., Handy, column 7, lines 35-37.

the lookup table; and transmitting the data file to the secondary identification code server,” as recited in claim 69. Since Handy fails to teach each and every element of claim 69, claim 69 is not anticipated by Handy.

Independent claims 90, 111, 112, 143, 157, 171, and 172, although of different scope, recite language similar to claim 69. Claims 90, 111, 112, 143, 157, 171, and 172 are not anticipated by Handy for at least reasons similar to those discussed above with respect to claim 69.

For at least this reason, claims 69, 90, 111, 112, 143, 157, 171, and 172 are not anticipated by Handy. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of these claims under 35 U.S.C. § 102(b).

Claims 70-76, 80-81, 83-86, 88-89, 91-97, 101-102, 104-110, 145-153, 155-156, 158-167, and 169-170 depend from and add additional features to independent claims 69, 90, 111, 112, 143, 157, 171, and 172. Accordingly, these claims are allowable for at least the reasons set forth above.

D. Claim Rejections - 35 U.S.C. § 103(a)

Claims 77-79, 82, 87, 98-100, 103, 154, and 168³ stand rejected under 35 U.S.C. § 103(a) as being anticipated by Handy.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination,

³ Although the Office Action does not list claim 168 as being rejected under either 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a), Applicants understand it to be included in the rejection under 35 U.S.C. § 103(a) because of its similarity to claim 154.

must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

The Office Action has failed to establish a *prima facie* case of obviousness for at least the reason that Handy fails to teach or suggest each and every element of claims 77-79, 82, 87, 98-100, 103, 154, and 168.

Claims 77-79, 82, and 87 each depend from claim 69 and thus require all the elements and limitations of claim 69. As discussed above, Handy fails to teach or suggest at least the following elements of claim 69: “generating a data file, using the service area table corresponding to the secondary identification code server to identify identification files in the lookup table; and transmitting the data file to the secondary identification code server.” Claims 77-79, 82, and 87 are therefore allowable for at least the reasons discussed above with respect to claim 69.

Independent claims 90, 143, and 157, although of different scope, recite language similar to claim 69. Claims 98-100, 103, 154, and 168 depend from and add additional features to independent claims 90, 143, and 157. Accordingly, these claims are allowable for at least the reasons set forth above and Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 103(a).

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Attachments: Replacement Drawing Sheets